

EXHIBIT 16

**FIFTEENTH AFFIRMATIVE DEFENSE – LACHES, INEQUITABLE
CONDUCT, AND UNCLEAN HANDS**

15. Netlist is barred, in whole or in part, under principles of equity, including laches, prosecution laches, inequitable conduct, and/or unclean hands. Netlist is also barred by issue preclusion from reasserting or altering its positions on factual and legal issues that were previously adjudicated.

16. Individuals substantively involved in the prosecution of the '506 ~~patent~~Patent knew about material and non-cumulative prior art by virtue of their participation in JEDEC standards meetings. On information and belief, these individuals specifically intended to deceive the Patent Office into believing that the claims of the '506 ~~patent~~Patent were patentable by withholding the relevant art from the examiner during prosecution of the patent.

1.A. Background on the Alleged Invention, ~~and~~ the Prosecution of the '506 Patent, and Events Occurring During the Same

17. The '506 ~~patent~~Patent issued from a series of continuation applications: U.S. Patent Application Nos. 15/820,076 (U.S. Patent No. 10,268,608); 15/426,064 (U.S. Patent No. 9,824,035); 14/846,993 (U.S. Patent No. 9,563,587); and 13/952,599 (U.S. Patent No. 9,128,632).

This chain of continuation applications ultimately claims priority to U.S. Provisional Patent Application No. 61/676,883, which was filed on July 27, 2012. All ~~of~~ the applications name Hyun Lee and Jayesh R. Bhakta as the inventors.

18. The '506 ~~patent~~Patent incorporates by reference a number of Netlist's other patent applications, including U.S. Patent Application Nos. 14/715,486 (U.S. Patent

No. 9,858,821); 13/970,606 (U.S. Patent No. 9,606,907); 12/504,131 (U.S. Patent No. 8,417,870); 12/761,179 (U.S. Patent No. 8,516,185); 13/287,042 (U.S. Patent No. 8,756,364); and 13/287,081 (U.S. Patent No. 8,516,188).

19. Netlist filed a terminal disclaimer for the '506 ~~patent~~Patent on April 10, 2020, over the '608, '035, '587, and '632 patents.

a. ~~a.~~ Hyun Lee's and Jayesh Bhakta's Alleged Conception and Reduction to Practice, and Regular Attendance at JEDEC Meetings

20. Hyun Lee continued to regularly attend JEDEC meetings for at least the JC-40 committee and the JC-45 committee in 2011 and 2012, as well as before and after that ~~timeframe~~time frame. For instance, on information and belief, Hyun Lee attended at least the following JC-40 meetings: No. 168, Dec. 8, 2011; No. 169, Mar. 5, 2012; and No. 170, June 4, 2012. And, on information and belief, Hyun Lee attended at least the following JC-45 meetings: No. 33, Dec. 7-8, 2011; No. 34, Mar. 5, 2012; and No. 35, June 4, 2012.

21. By virtue of his attendance at those meetings, active involvement in JEDEC and otherwise, on information and belief, Hyun Lee was aware of the draft and final specifications for DDR4 LRDIMMs being considered and voted upon by those committees, including JESD82- 32, dated November 2016, as well as prior drafts of it. For example, Intel presented and discussed Committee Item Number 158.01 ("DDR4 LRDIMM Proposal") at the December 8, 2011 meeting of JC-40, Committee Item Number 0311.14 ("Proposed DDR4 DB Training Modes") at the March 25, 2012 meeting of JC-40, and Committee Item Number 0311.12 ("Proposed DDR DB Buffer Control Words") at the June 4, 2012 meeting of JC-40.

22. On information and belief, the JESD82-32 standard was circulated at or before, and discussed at and voted on at or before, the JC-40 and JC-45 committee meetings that Hyun Lee attended.

23. On information and belief, draft Committee Item Number 158.01 was created by employees of Intel Corp. and circulated at or before, and discussed at, the JC-40 committee meeting on December 8, 2011 that Hyun Lee attended.

24. On information and belief, draft Committee Item Number 0311.14 was created by employees of Intel Corp. and circulated at or before, and discussed at, the JC-40 committee meeting on Mar. 5, 2012 that Hyun Lee attended.

25. On information and belief, draft Committee Item Number 0311.12 was created by employees of Intel Corp. and circulated at or before, and discussed at, the JC-40 committee meeting on June 4, 2012 that Hyun Lee attended.

26. By virtue of his attendance at those meetings, active involvement in JEDEC and otherwise, on information and belief, Hyun Lee was aware of the draft and final specifications for DDR4 LRDIMMs being considered and voted upon by those subcommittees.

27. Draft specifications, ballots, and presentations distributed to the members of the JC-40 and/or JC-45 committees of JEDEC were distributed to many (20+) key members of the interested public with the expectation they would be freely disclosed to and discussed with others. As such, they are prior art under 35 U.S.C. § 102 at least as of those distribution dates.

28. Distributed specifications, such as JESD82-32, are prior art under 35 U.S.C. § 102 at least as of their release dates.

29. The provisional application to which the '506 ~~patent~~Patent claims priority was filed on July 12, 2012, naming Hyun Lee as the inventor. Jayesh R. Bhakta was named as a co-inventor after the provisional was filed.

30. On information and belief, and based on Netlist's apparent view of the scope of the alleged invention, each of the draft DDR4 LRDIMM drafts and presentations disclose materially the same structure and functionality that Netlist accuses of infringing the claims of '506 ~~patent~~Patent.

31. On information and belief, after attending the June 4, 2012 meeting and listening to these ideas from other members of JEDEC, Hyun Lee returned to Netlist and hurriedly completed drafting the provisional application to which the '506 ~~patent~~Patent claims priority, naming himself as the inventor, and had a provisional application filed on July 27, 2012. Netlist filed a request to correct inventorship on September 26, 2012, adding Jay R. Bhakta as a co-inventor.

2. ~~b.~~ **'506 Patent Prosecution and Corresponding Events**

32. Netlist filed the application, No. 16/391,151, that issued as the '506 ~~patent~~Patent on April 22, 2019.

33. On August 20, 2019, Netlist filed an Information Disclosure Statement (IDS) Form containing seven sheets. JEDEC DDR LRDIMM drafts and specifications were not included.

34. On January 8, 2020, Netlist filed an Information Disclosure Statement (IDS) Form containing twenty-two sheets. The cited references include numerous entire

prosecution histories for other Netlist applications. JEDEC DDR LRDIMM drafts and specifications were not included.

35. On January 10, 2020, the examiner issued a Non-Final Rejection rejecting then- pending claim 1 for obviousness-type double patenting and as anticipated by U.S. Patent No. 8,565,033 (“Manoharajah”).

36. On April 10, 2020, Netlist filed an Amendment and Request for Reconsideration after Non-Final Rejection. Netlist’s response included a Terminal Disclaimer and canceled claim 1. Netlist added claims 2–21.

37. On July 23, 2020, the examiner issued a Notice of Allowance for the application that issued as the ’506 ~~patent~~Patent.

38. On October 16, 2020, Netlist filed an Amendment after Allowance, and on October 22, 2020, Netlist paid the issue fee for the application that issued as the ’506 ~~patent~~Patent.

39. On November 11, 2020, the examiner accepted the Amendment.

40. On November 18, 2020, the examiner issued an issue date notification for the application that issued as the ’506 ~~patent~~Patent. That notification specified an issue date of December 8, 2020.

41. Netlist took no action to withdraw the application that issued as the ’506 ~~patent~~Patent from issuance, or to otherwise continue prosecution of that application, and the application issued as the ’506 ~~patent~~Patent on December 8, 2020.

2.B. Netlist’s Failure to Disclose the Drafts and Presentations for DDR4 LRDIMMs from the Dec. 8, 2011, Mar. 5, 2012, and June 4, 2012 JEDEC JC- 40 Meetings Attended by Hyun Lee, and False Portrayal

of Hyun Lee and Jayesh R. Bhakta as Inventors.

42. At least according to Netlist's characterizations of the inventive aspects of the disclosure and claims of the '506 ~~patent~~Patent, the draft specifications and related presentations for DDR4 LRDIMMs that were presented at the Dec. 8, 2011, Mar. 5, 2012, and June 4, 2012 meetings disclose the key allegedly inventive aspects of the claims of the '506 ~~patent~~Patent. These draft specifications and presentations include Committee Item Number 158.01 from the December 2011 meeting ~~(Ex. B)~~, Committee Item Number 0311.14 from the March 2012 meeting ~~(Ex. C)~~, and Committee Item Number 0311.12 from the June 2012 meeting ~~(Ex. D)~~.

43. Even though at least Hyun Lee was present at the JEDEC meeting at which those presentations were made, witnessed those presentations, and was present for the discussions that occurred about them, and immediately thereafter drafted the provisional application to which the '506 ~~patent~~Patent claims priority, on information and belief, Hyun Lee did not disclose any of these drafts and the presentations to the examiner of the application that issued as the '506 ~~patent~~Patent.

44. Those drafts and presentations are prior art under 35 U.S.C. § 102 at least as of the meeting in which they were presented and discussed, and are not cumulative of other art or information before the examiner of the application that issued as the '506 ~~patent~~Patent.

45. Those drafts and presentations also illustrate that Hyun Lee falsely portrayed himself and Jayesh R. Bhakta as the inventors of the alleged inventions claimed in the '506 ~~patent~~Patent. At a minimum, those drafts and presentations

illustrate that Hyun Lee, based on Netlist's infringement allegations, derived at least portions of the allegedly inventive aspects of the claimed inventions from others in attendance at the JC-40 meetings, who made those presentations on behalf of Intel, among others.

46. The Patent Office would not have allowed at least one claim~~-of each~~ of the '506 ~~patents~~Patent to issue had it been aware of those drafts and presentations, at least because it would have found the claims obvious over those drafts and presentations (either in combination with the knowledge of one of ordinary skill~~;~~or in combination with art disclosing the basic architecture and functionality of DDR4 LRDIMMs), that there are joint inventors that were not properly named on the applications that issued as the '506 ~~patent~~Patent, and/or that the alleged inventions claimed therein had been derived in whole or in part from another.

47. The drafts and presentations that Hyun Lee failed to disclose to the Patent Office were not cumulative of other art before the examiner. The examiner stated that he allowed the claims because the art of record did not teach or suggest:

a memory controller system with memory modules having control and address signal lines implemented to be used corresponding to memory read operations to and from memory devices of the memory module that are arranged in multiple ranks with data buffers couple to memory devices, where memory read operations output read data and read strobes associated with memory read operations, and where the data buffer implemented delaying of a first read strobe by a predetermined amount, i.e. generating a delayed read strobe, sampling the first section of read data using the delayed read strobe, and transmitting the section of read data to a data bus, where the predetermined amount of delay is based at least on signals received by the data

buffer [during one or more previous operations] as claimed.

Notice of Allowability at 3–4. The withheld drafts and presentations for DDR4 LRDIMM explained the structure and operation of DDR4 LRDIMM devices, which Netlist argues practice the claims of the '506 ~~patent~~Patent. For example, Committee Item Number 158.01-~~(Ex. B)~~, shows the accused DDR4 LRDIMM's structure, which Netlist argues includes the claimed "memory devices of the memory module that are arranged in multiple ranks with data buffers couple to memory device." ~~Ex. B~~Committee Item No. 158.01 at 2. Moreover, the draft specifications explain DDR LRDIMM's training modes including "Read Delay Training." *See, e.g.,* ~~Ex. C~~ (Committee Item No. 311.14) at 8–9. Netlist argues that these training modes are used to determine the claimed "predetermined amount."

48. On information and belief, Hyun Lee specifically intended to deceive the Patent Office into believing that Hyun Lee and Jayesh R. Bhakta were the sole inventors of the '506 ~~patent~~Patent, and/or that the claims of those patents are otherwise patentable, by withholding those drafts and presentations from the patent examiner during prosecution of the application that issued as the '506 ~~patents~~Patent. On information and belief, Hyun Lee engaged in this conduct as part of a scheme to monetize Netlist's patents through litigation against the industry.

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49. Inequitable Conduct: Any one or more acts set forth above are sufficient in and of itself/themselves to demonstrate that Netlist committed inequitable conduct

during the prosecution of the '506 ~~patent~~Patent that renders the '506 ~~patent~~Patent unenforceable.

50. Unclean Hands: Furthermore, any one or more acts set forth above are sufficient in and of itself/themselves ~~demonstrated~~to demonstrate that Netlist has unclean hands in relation to its assertion of the '506 ~~patent~~Patent that renders the '506 ~~patent~~Patent unenforceable.